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09/033,832	03/03/98	MOSHER	W PRECI-P536
		PM82/0726	EXAMINER GREEN, B
THOMAS P MAHONEY 660 NEWPORT CENTER DRIVE SUITE 710 NEWPORT BEACH CA 92660		ART UNIT 3628	PAPER NUMBER 14
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 14

Application Number: 09/033,832

Filing Date: 03/03/98

Appellant(s): Walter W. Mosher, Jr. et al.

Thomas P. Mahoney
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed July 13, 2000.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

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The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 19-20; 21-24; and 25,27 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

4,718,374	Hayes	01-1988
4,612,719	de Jong	09-1986
5,140,946	Pennock et al.	08-1992

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(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 20, lines 2-3, there is no antecedent basis for “said circuit means”.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 25 is rejected under 35 U.S.C. 102(b) as being anticipated by Hayes (U.S. Patent No. 4,718,374).

Hayes shows in figures 1-5 a reusable securement means comprising a body (22) with securement portions (45,100,102,104,106) and a radio frequency identification circuit means (60). The intended use of the device has not been given any patentable weight. The securement portions engage the ends of attachment means (24,114).

Claim Rejections - 35 USC § 103

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 19-25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over de Jong (U.S. Patent No. 4,612,719) in view of Hayes (U.S. Patent No. 4,718,374).

de Jong shows in figures 8 and 9 a band (6), a securement means (1,90), and a responder (2). de Jong does not disclose whether the responder includes a radio frequency circuit means and the idea of embedding the responder within the securement means in the embodiment shown in figures 8 and 9. The responder (2) is considered to be embedded in the securement means. Hayes shows in figures 1-5 a securement means comprising a body (22) having a radio frequency identification circuit means (60) embedded therein. In view of the teachings of Hayes it would have been obvious to one in the art to modify de Jong by including a radio frequency circuit means within the responder since this would allow information from the responder to be sent out and received in an easier manner. de Jong shows in figure 1 the idea of embedding the responder within the securement means. In view of the teachings of figure 1 of de Jong it would have been obvious to one in the art to modify figures 8 and 9 of de Jong by embedding the responder within the securement means since this would allow the responder to be attached to the securement means in a more secure manner.

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5. Claims 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pennock et al. (U.S. Patent No. 5,140946) in view of Hayes (U.S. Patent No. 4,718,374).

Pennock et al. shows in figures 1-2 a band (40) and a securement means (10). Pennock et al. does not disclose placing a radio frequency circuit means within the securement means. Hayes shows in figures 1-5 a reusable securement means comprising a body (22) with securement portions (45,56,106,168) and a radio frequency identification circuit means (60). In view of the teachings of Hayes it would have been obvious to one in the art to modify Pennock et al. by including a radio frequency circuit means within the securement means since this would allow the animal to be identified and information with regard to the animal to be relayed to another location.

(11) Response to Argument

In regard to the appellant's argument that 20 is not indefinite under 35 U.S.C. 112 second paragraph since claim 19 only defines one circuit so it is clear in claim 20 as to what circuit is being referred to. The applicant defines in claim 19 a "radio frequency identification circuit" and in claim 20 (which depends on claim 19) defines "said circuit means". The examiner maintains that there is no antecedent basis for "said circuit means". Circuit and circuit means do not have the same meaning and coverage so it is not clear how claim 20 should be interpreted.

In regard to the appellant's argument that the examiner has also rejected claim 19 (in the advisory) under 112 second paragraph. The examiner did not reject claim 19 in the advisory action. The examiner was only suggesting a change in claim 19 to correct the 112 second

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paragraph error appearing in claim 20. Claim 20 is the only claim rejected under 35 U.S.C. 112 second paragraph.

In regard to the appellant's argument that Hayes fails to teach a reusable securement means. Reusable is a broad term and can be interpreted in many ways. The fact that the securement means is left on the animal for multiple days makes the securement means reusable, i.e. reused each day. Further, the attachment (24) could be cut off and the securement means removed from the animal. The securement means would then be sterilized and attached to another animal, i.e. reused. The securement means of Hayes is "capable" of being reused. It is the examiner's position that since the securement means of Hayes can perform the function of being reused than the rejection is proper. It is well established that a recitation with respect to the manner in which an apparatus is intended to be employed, *i.e.*, a functional limitation, does not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim. In re Pearson, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974); In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); In re Otto, 312 F.2d 937, 136 USPQ 458 (CCPA 1963). Where the prior art reference is inherently capable of performing the function described in a functional limitation, such functional limitation does not define the claimed apparatus over such prior art reference, regardless of whether the prior art reference explicitly discusses such capacity for performing the recited function. In re Ludtke, 441 F.2d 660, 169 USPQ 563 (CCPA 1971). In addition, where there is reason to believe that such functional limitation may be an inherent characteristic of the prior art reference, Applicant is

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required to prove that the subject matter shown in the prior art reference does not possess the characteristic relied upon. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990); In re King, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986); In re Lutkje, 441 F.2d at 664, 169 USPQ at 566 (CCPA 1971); In re Shreiber, ___ F.2d at ___, 44 USPQ2d 1429 (Fed. Cir. 1997).

In regard to the appellant's argument that the head portion of Hayes is not demountably engageable with opposite extremities of disposable attachment means. The examiner disagrees since Hayes shows in figure 5 that the securement means engages the attachment member (24) at the upper and lower extremities. Further, the securement means of Hayes is "capable" of being attached to opposite extremities of a given type of attachment means, i.e. an attachment means that includes a strip portion that connects at one end to the portion (55) and at the other end to portion (48).

In regard to the appellant's argument that there is no radio frequency circuit means embedded in the head portion 46 of Hayes. The circuit means does not have to be embedded in the head portion 46 of Hayes. The appellant defines in claim 25 that the circuit means is embedded in the body. Hayes shows in figures 1-5 a body (22) that includes a circuit means (60) embedded in the body.

In regard to the appellant's argument that Hayes clearly states that the head portion 46 may not be withdrawn through the slot after assembly on the animal ear. In order to reuse the body (22) of Hayes the attachment (24) would be broken. This would allow the body to be separated

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from the attachment. Further, when the body is left on the animal day after day, the body is considered to be reused. Also, as long as the body of Hayes is “capable” of being reused it is considered to read on the applicant’s claim 25.

In regard to the appellant’s argument that de Jong in view of Hayes fail to disclose the use of a reusable securement means. de Jong shows in figures 8 and 9 a band (6), a body (1) with a securement means (90), and a responder (2). The body and securement means of de Jong are a unitary member. The securement means is considered to include the body. The securement means of Hayes is “capable” of being reused. It is the examiner’s position that since the securement means of Hayes can perform the function of being reused the rejection is proper.

In regard to the appellant’s argument that Pennock et al. fails to include a RFID circuit therein and that there is not reason to add one to it. Pennock et al. teaches the use of an illuminated pet collar. It is well known to place tags on pet collars to indicate the name of the pet, it’s owner’s name, rabies certification, etc. Hayes discloses the idea of embedding a chip within a tag for allowing information to be stored in the chip and transmitted to a receiver. Embedding a chip as taught by Hayes would allow the device of Pennock et al. to store a large amount of information (pet’s name, owner’s name, medical information, etc.) with regard to the animal which could be easily retrieved with the use of a processor means. Further, the chip could be used to help in determining the animal’s location at any given time.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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